

## REMARKS

### *General:*

Claims 1-3 and 5-13 are pending in this application. Claims 1-3 and 5-13 stand rejected.

### ***35 U.S.C. §112 rejection and objection to the drawings:***

Claims 5 and 12 stand rejected as not being enabled by the disclosure, and the drawings stand objected to, on the ground that claims 5 and 12 recite an upper portion adapted to rotate 360° “about an axis perpendicular to the lower portion,” where the examiner considers that the drawings show 360° rotation only about an axis “parallel” to the lower portion. However, the examiner never explains the basis for his arbitrary choice of direction. Specifically, the examiner never identifies any aspect of the lower portion to which the axis of rotation through 360° is “parallel.” The only axis shown in diagram a) on page 4 of the office action is the actual axis of rotation. If the examiner is arguing that axis must be parallel to itself, that cannot be correct, because it empties the requirement for parallelism of all meaning.

The choice of frame of reference is not for the examiner to make. The applicant may act as “his own lexicographer” and may define claim terms as he chooses. *Texas Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1204, 64 USPQ2d 1812, (Fed. Cir. 2002), *cert. denied*, 538 U.S. 1058 (2003). The axis of rotation of the leg 24 is clearly defined in the specification, paragraph [0028] as *perpendicular* to the lower portion. This suggests that the datum is the plane of the disk in which the bottom leg 24 or the base member 37 is journaled, but it is not necessary to resolve that question. Claims 5 and 12 recite 360° rotation about an axis “perpendicular to the lower portion.” The specification describes the drawings as showing 360° rotation about an axis “perpendicular to the lower portion.” The specification supports the claim. The drawing shows what is claimed. The rejection and objection are traversed.

***Claim objection:***

As requested by the examiner, claim 6 has been amended to make explicit that the “light bulb” is received in the “portion for receiving a light bulb.”

***35 U.S.C. § 102:***

Claims 1, 2, 5, 6, and 13 stand rejected as anticipated by U.S. Patent No. 2,190,439 (Wohl). It is noted that the examiner’s anticipation rejection differs from his previous obviousness rejections by asserting that “Wohl discloses an illumination device having ... the rotatable upper portion being adapted to rotate at least 360° about an axis perpendicular to the rotatable upper portion,” a proposition that the examiner has previously acknowledged to be false. The examiner cites to col. 1, lines 6-10 of Wohl, which reads:

It is the object of the present invention to provide a socket of this type which permits the lamp in the socket to assume all radial directions of a hemisphere without the use of a universal or ball joint.

As explained in applicants’ previous responses, this does not require a 360° rotation. Wohl can, and does, reach all radial directions of a hemisphere by combining two 180° rotations.

The examiner asserts that “the recitation that an element is ‘adapted to’ perform a function or serve in a given application is not a positive limitation, but only requires the ability to so perform.”<sup>1</sup> That does not assist the examiner. The “ability to perform a function” can impose a positive limitation on structure. An attachment capable of rotating at least 360° is structure. The structure of Wohl is not a structure capable of rotating at least 360° about an axis perpendicular to the rotatable upper portion, or any other axis. Thus, Wohl does not anticipate claim 1, claim 13, or any claim dependent from claim 1.

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<sup>1</sup> In support of his position, the examiner refers to *In re Hutchinson*, 69 USPQ 138 (CCPA 1946). The language of *Hutchinson* is perfectly ambiguous as to whether the Presiding Judge was intending to lay down a general rule, or merely to find on the facts of the case that the specific functional statements were non-limiting. Even if the Presiding Judge was stating a general rule, it does not assist the examiner, because the statements were non-limiting as being in the preamble of the claims, without reaching the question of how they should be interpreted. In any case, the value of *Hutchinson* as precedent is fairly shown by the fact that it has apparently been cited as precedent only once in nearly 60 years, and that on a different point.

If the examiner disagrees, the applicants hereby call for an affidavit of the examiner under 37 C.F.R. § 1.104(d)(2) showing by facts within the personal knowledge of the examiner that the structure of Wohl is in fact capable of rotating at least 360° about an axis perpendicular to the rotatable upper portion.

Claims 1, 2, 5, 6, and 13 are further deemed non obvious over Wohl for the reasons set forth in applicants' previous response, which the examiner does not rebut.

***35 U.S.C. §103:***

Claims 8, 9, 11, and 12 stand rejected as obvious over Wohl. The examiner's rejections rely on ignoring the fact that claim 8, and claims 9, 11, and 12 as dependent from claim 8, are limited to a structure capable of rotating 360°. Claims 8, 9, 11, and 12 are deemed patentable over Wohl for at least the same reasons as claim 1.

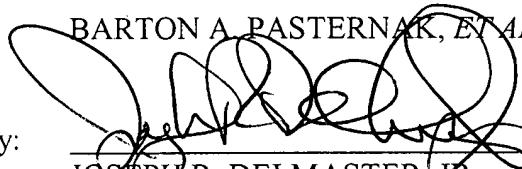
Claims 3 and 10 stands rejected as obvious over Wohl in view of Angott. Claim 3 is dependent from claim 1, claim 10 is dependent from claim 8, and Angott is cited only as showing the additional feature recited in claims 3 and 10. Without prejudice to their individual merits, claims 3 and 10 are therefore deemed patentable over the combination of Wohl and Angott for the same reasons as claims 1 and 8 are patentable over Wohl alone.

No ground for the rejection of claim 7 has been stated, and claim 7 is therefore deemed patentable for the reasons of record.

***Conclusion:***

In view of the foregoing, it is believed that the present invention, as now claimed, is not obvious over the cited references. Reconsideration of the examiner's rejections and objection, and an early notice of allowance of all claims, are earnestly solicited.

Respectfully submitted,

By:   
BARTON A. PASTERNAK, ESQ.  
JOSEPH R. DELMASTER, JR.  
Registration No. 38,123  
Drinker Biddle & Reath, LLP  
One Logan Square  
18<sup>th</sup> and Cherry Streets  
Philadelphia, PA 19103  
202-842-8879  
(215) 988-2757 (fax)  
Attorney for Applicants